

REMARKS

Claims 1-17, and 20-25 are currently pending in the subject application and are presently under consideration. Claims 1, 4 - 6, 7, 9-11, 14-16, 17, 20, 21 and 23 have been currently amended while claims 12, 18 and 19 have been canceled. New claims 24-26 have been added. A listing of claims is shown on pages 2-5 of the Reply. Support for the aforementioned amendments can be found in the specification as filed at paragraphs [0024], Fig.4 and related text at paragraph [0031]. Applicants' representative thanks the Examiner for the teleconference of February 21, 2008 wherein merits of the subject claims in view of the cited art were discussed.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Objection of Claims 6-10

Claims 6-10 are objected to because of minor informalities. Claim 6 has been amended to cure the minor informalities pointed out by the examiner. Accordingly, withdrawal of this objection is requested.

II. Rejection of Claims 16-23 Under 35 U.S.C. §101

Claims 16-23 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Withdrawal of this rejection is requested in view of the amendment to independent claim 16 in accordance with the Examiner's suggestion.

III. Rejection of Claims 1-23 Under 35 U.S.C. §102(e)

Claims 1-23 stand rejected under 35 U.S.C. §102(e) as being anticipated by Friedman *et al.* (U.S. 7,039,806). Withdrawal of this rejection is requested for the following reasons. The cited reference fails to disclose or suggest all aspects set forth in the subject claims.

A single prior art reference anticipates a patent claim only if it *expressly or inherently describes each and every limitation set forth in the patent claim*. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The *identical invention must be shown in as complete detail as is contained in the ...*

claim. Richardson v. Suzuki Motor Co., 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

The claimed invention relates to protection and tracking of information distributed in electronic form. To this end, amended independent claim 1 recites *a method of storing digitally-encoded material, the method comprising: associating a unique identifier with the digitally-encoded material; and associating one or more built-in functions with the digitally-encoded material such that the unique identifier and the built-in functions are coupled to the digitally-encoded material, the built-in functions governing transforms and rendering of the digitally-encoded material, wherein the digitally-encoded material can be transformed and rendered only by the built-in functions*. Independent claims 6, 11, 16 and 21 recite similar features. Friedman *et al.* is silent regarding such novel features.

Friedman *et al.* relates to a method for packaging and transmitting data over a network. At page 4 of the Office Action, the Examiner contends that Friedman *et al.* teaches such novel features. Applicant's representative avers to the contrary. In accordance with the subject invention, digital data is encoded, a unique identifier is created using an algorithm and the combination is encrypted using a strong encryption process. Built-in functions to perform transform and render operations on the file, like decrypt, copy, print, encrypt etc, are identified. Operations on the data can be performed only with the provided built-in functions and not with other similar functions. They also help in keeping records of the number of copies made, notifying the document originator that a copy has been made, prevent copies of files from functioning in different locations, document version control etc. A three component document, which is a combination of the encrypted data, unique identifier, and the built-in functions is then sold as a single entity. At the cited portions, Friedman *et al.* discloses a package of information comprising a data file to be transmitted, a permission database that defines access rights for the data file and optionally, encryption software being packaged along with a package unique identifier. The package unique identifier is unique for that package and is not a unique identifier associated with the stored digitally-encoded material. Further, the permission database defines access rights given to the receiver of the data files, and rendering of the data file depends on the permissions granted. In contrast, the built-in functions comprising at least encrypt/decrypt functions are coupled with the digitally-encoded material so that the material can only be

transformed by the functions thereby mitigating manipulation of the digital material by external functions. Thus, Friedman, *et al.* is silent regarding the aforementioned claimed features.

Accordingly, it is requested that this rejection with respect to independent claims 1, 6, 11, 16 and 21 (and the claims that depend there from) be withdrawn.

IV. New Claims 24, 25

Newly added claims 24 and 25 emphasize novel aspects of the invention discussed *supra* in connection with claims 1-23. Accordingly, these claims are patentably distinct over the art of record for at least the same reasons as are claims 1-23.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP1150US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,

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